

## **REMARKS**

Applicants thank Examiner Venkat for the courtesy extended to Applicants' representative during the interview of April 16, 2007. The content of the interview summary dated April 16, 2007, accurately reflects the substance of the interview.

### **I. Status of Claims**

Claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221, and 223 are currently pending in this application.<sup>1</sup> Applicants thank the Office for acknowledging the IDS filed on October 20, 2006.

### **II. Rejections Under 35 U.S.C. § 103(a)**

The Office has rejected claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221, and 223 under 35 U.S.C. § 103(a) as being obvious over the combination of U.S. Patent Nos. 5,783,657 ("Pavlin"), 3,148,125 ("Strianse"), and 6,214,329 ("Brieva"). Applicants respectfully traverse this rejection for the reasons already of record and those set forth below.

The Office asserts that Pavlin discloses the claimed structuring polymer and liquid fatty phase, see January 17, 2007, Office Action ("Office Action") at 3, but admits that it does not teach at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature, see May 5, 2004, Office Action at 4. The Office also asserts that

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<sup>1</sup> Although the Continuation Sheet (PTOL-326) excludes claims 153, 166 and 169, the Office Action sets forth the complete listing of pending claims in this application at page 2.

Strianse teaches a polyamide resin, although not a claimed polyamide polymer, a liquid fatty phase, and a pasty fatty substance. See Office Action at 4-5. Finally, the Office relies on Brieva for a teaching of waxes, coloring agents, amphiphilic compounds, and volatile and non-volatile oils in combination with compounds that function as gelling agents. See Office Action at 4. The Office continues to assert that the motivation to combine the ingredients from these various references “flows logically from the art for having been used in the same cosmetic art,” and one would expect the resultant product to have the structured and transparent properties disclosed therein. *Id.* at 4. Applicants disagree.

In making a rejection under 35 U.S.C. § 103, the Office has the initial burden to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143. In its recent decision in *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (U.S. Apr. 30, 2007) at 2, the Supreme Court confirmed that the “framework for applying the statutory language of §103” was still based on their landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966). Under *Graham*, there are four factors to be considered when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

As detailed below, when the references cited by the Office are considered in view of these factors and in light of the Supreme Court’s most recent guidance on obviousness as provided in *KSR*, it is evident that the Examiner has not established a *prima facie* case of obviousness, even in light of the *KSR* decision.

**A. The Cited References Do Not Teach All the Claim Limitations**

The teachings of the prior art differ from the claims at issue in that none of the references relied on by the Office, when taken alone or in combination, teach all the claimed limitations. Specifically, none of the references disclose the claimed pasty fatty substance comprising at least one liquid fraction and at least one solid fraction at room temperature.

The Office relies on Strianse for its alleged teaching of pasty fatty substances, identified by the Office as the lanolin alcohols and ethoxylated lanolin alcohols of the examples at column 3. See Office Action at 5; see *also* Interview Summary. The Office asserts that these compounds belong to the claimed pasty fatty substances because page 26 of the present specification describes pasty fatty substances as including “lanolins and lanolin derivatives such as acetylated lanolins or oxypropylenated lanolins or isopropyl lanolate.” See Office Action at 6.

Applicants disagree with the Office’s characterization. The Office repeatedly ignores the claim element that the pasty fatty substance have “at least one liquid fraction and at least one solid fraction at room temperature.” See claim 121 (emphasis added). While Strianse does disclose “lanolin alcohols” and “ethoxylated lanolin alcohols” in examples 2-4, at column 3, these compounds are not the same as the “lanolin derivatives” of the claimed pasty fatty substance described on pages 26 of the specification because they lack a solid fraction at room temperature as in the present claims. Rather, Strianse teaches that the lanolin alcohols in the examples exist as liquids. In the paragraph bridging columns 2-3, Strianse teaches that the compositions described therein may be modified with “other polyamide solvents discussed herein, especially . . . fatty alcohols.” The lanolin alcohols and ethoxylated lanolin alcohols in

examples 2-4 are fatty alcohols.<sup>2</sup> The reference to such fatty alcohols as “solvents” indicates that they are liquids, not solids. Moreover, Strianse also teaches transparent or “crystal clear” compositions “free from all opaque materials,” such that waxes “should be avoided.” Col. 1, ln. 31, col. 3, lns. 4 and 43-51. This further indicates that the lanolin alcohols and ethoxylated lanolin alcohols used in the examples are liquids because the compositions should not contain materials with solid or crystalline components.

Likewise, the fatty acid esters disclosed in Strianse are identified as “solvents” and, thus, are liquids, not solids. See col. 2, ln. 71 - col. 3, ln. 3. Indeed, the examples of fatty acid esters in Strianse are all liquids. See col. 3, lns. 1-3, 48-49 (listing polyethylene glycol monolaurate, polyethylene glycol (400) monolaurate, castor oil, and lauryl lactate). Therefore, they do not contain a solid fraction required for the claimed pasty fatty substance either.

The Office requested that Applicants specify the compounds that “meet the claim requirement of having solid fraction and liquid fraction.” See Interview Summary. The specification of the present application clearly defines the scope of the claimed “pasty fatty substance.” The specification states that “[a] pasty fatty substance is a viscous product comprising a liquid fraction and a solid fraction,” including “a fatty substance with a melting point ranging from 20 to 55 °C . . . and/or a viscosity at 40 °C ranging from 0.1 to 40 Pa.s. . . .” Specification at 25, lns. 9-16. The specification goes on to

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<sup>2</sup> Applicants respectfully wish to clarify that lanolin alcohols and ethoxylated lanolin alcohols are not fatty acid esters as the Office indicated at page 5 of the November 23, 2005, Office Action. Rather, lanolin alcohols are the alcohol products resulting from hydrolysis of lanolins, which are fatty acid esters. See “Lanolin Alcohol,” International Cosmetic Ingredient Dictionary and Handbook (“CTFA”), 7<sup>th</sup> ed., p. 718 (1997), attached as Exhibit 2. And while Strianse does teach “fatty acids esters” generally (see

specify methods by which the melting point and viscosity may be measured. *See id.* at 25, Ins. 15-21.

Additionally, representative pasty fatty substances having at least one solid fraction and at least one liquid fraction at room temperature are listed on pages 25-26 of the specification, including:

- lanolins and lanolin derivatives having a viscosity of from 18 to 21 Pa.s and/or a melting point from 30 to 55° C, such as acetylated lanolins, oxypropylenated lanolins, and isopropyl lanolate;
- esters of fatty acids or of fatty alcohols, such as those containing from 20 to 65 carbon atoms, having melting points of about from 20 to 35 °C and/or viscosity at 40 °C ranging from 0.1 to 40 Pa.s, such as triisostearyl citrate or cetyl citrate;
- arachidyl propionate;
- polyvinyl laurate;
- cholesterol esters, such as triglycerides of plant origin, such as hydrogenated plant oils, such as derivatives of hydrogenated castor oil, such as "Thixinr" from Rheox;
- viscous polyesters such as poly(12-hydroxystearic acid); and
- silicone pasty fatty substances, such as polydimethylsiloxanes having alkyl or alkoxy pendant chains containing from 8 to 24 carbon atoms, and a melting point of from 20 to 55 °C, such as stearyldimethicones.

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paragraph bridging column 2-3), it does not disclose lanolins.

The specification further clarifies that those substances existing as a liquid or wax at room temperature are not pasty because they lack either a liquid fraction or a solid fraction. See specification at page 6, lns. 12-19. Thus, one of ordinary skill in the art, reading the application, would understand the scope of the term “pasty fatty substance,” wherein the substance “comprises at least one liquid fraction and at least one solid fraction at room temperature.”

Additionally, Applicants note that Brieva does not cure the deficiencies of Pavlin and Strianse as it does not teach the claimed pasty fatty substance either. The Office relies on Brieva only for its teachings of “waxes, coloring agents, amphiphilic [sic] compounds, volatile and non volatile oils.” Office Action at 4. Accordingly, the combination of Pavlin and Strianse further in view of Brieva does not meet all of the limitations of the present claims. For these reasons alone, the Office has not established evidence of a *prima facie* case of obviousness.

**B. There is No Evidence of Suggestion or Motivation to Combine the References**

Additionally, the Office has failed to demonstrate some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify Pavlin in view of Strianse and Brieva. In formulating a rejection under 35 U.S.C. § 103(a), an invention “composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR* at 15. While there is not a rigid rule requiring application of the “teaching, suggestion, or motivation” test, it can provide helpful insight in determining whether the claimed subject matter is obvious. See *id.* In the analysis supporting the rejection, “the apparent reason to combine known elements in the fashion claimed by the patent at issue . . . should be made explicit.” *Id.* at 14 (citing *In*

*re Kahn*, 441 F.3d 977, 988 (Federal Circuit, 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)).

Even assuming, for the sake of argument that Strianse did disclose the claimed pasty fatty substances, the Office has not provided sufficient motivation or an explicit reason prompting one of ordinary skill in the art to incorporate any particular compound from Strianse into the compositions of Pavlin. According to the Office, such motivation arises from the fact that both references disclose “clear transparent compositions” and that “clear compositions are useful to the consumer.” Office Action at 5. The fact that both compositions are transparent, however, would not alone be reason to combine the two and is not sufficient to satisfy the burden of establishing a *prima facie* case of obviousness. If both compositions possessed the desired transparent property, as the Office asserts, there would be no incentive and no logical reason to combine them, *i.e.*, nothing gained.

Furthermore, if anything, Strianse teaches away from the use of a pasty fatty substances in a composition because it teaches that a solid fraction would ruin the advantages of the product. For example, Strianse teaches that “insoluble opaque ingredients should be avoided” in order to retain “sparkle and depth of color.” Col. 3, Ins. 40-42. Likewise, “waxes should be avoided, as they create turbidity,” which would ruin the “crystal clear” quality of the compositions. *Id.* at col. 3, Ins. 4-8 and 43-44.

Additionally, Brieva fails to remedy the deficiencies of Pavlin and Strianse. Brieva does not provide motivation to combine Pavlin and Strianse, or to combine Brieva’s teachings with either of those references. The Office asserts that “[o]ne of

ordinary skill in the cosmetic art would use the specific oil of [Brieva] and combine it with the compositions of [Pavlin] and [Strianse] with the reasonable expectation of success that the incorporation of specific volatile oil into the compositions would not destroy the gel property since the same specific oil can be used with products having gel consistency.” Office Action at 6 (emphasis original). The Office’s assertion of a motivation to combine is improper. The expectation that a desired property would not be destroyed through the combination of references does not provide a motivation to combine them. Nor does the expectation that a desired property would not be destroyed equate with a reasonable expectation of success. Moreover, the fact that references can be combined is not sufficient to establish a *prima facie* case of obviousness. See M.P.E.P. §2143.01(III).

The Office also alleges that motivation to combine resides in Brieva’s disclosure of thickening agents at column 11, lines 40-60, which the Office identifies as “polymeric thickeners.” See Office Action at 7. However, Brieva’s list of thickeners consist of carbohydrate-based polymers, bearing no structural relationship to the claimed polyamides. Thus, one of ordinary skill in the art would not be motivated to combine the compounds of Brieva with the polyamide polymers of Pavlin or Strianse based on Brieva’s disclosure of thickeners of an entirely different structural class. Nor would one skilled in the art have any reasonable expectation of achieving the structured property of the claimed composition by substituting the polyamide polymers of Pavlin or Strianse for the carbohydrate-based thickeners of Brieva because those classes of compounds bear no structural relationship.

Accordingly, the Office has failed to establish a *prima facie* case of obviousness, and Applicants respectfully request reconsideration of the rejection.



### **III. Commonly Assigned Co-Pending Applications and Patents**

In the submissions previously filed in this case, Applicants noted information regarding co-pending applications, including the present application, and submitted copies of the pending claims as of the dates of those filings for every case identified. Applicants enclose herewith in Exhibit 1 copies of the claims in co-pending applications, which claims have been amended or issued since October 20, 2006: 10/450,108; 10/466,166; 10/699,780; and 10/993,430. Applicants submit these claims for the Office's convenience in evaluating any potential issues regarding statutory or obviousness-type double patenting.

### **IV. Conclusion**

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 6, 2007

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**Attachments:**      **Exhibit 1 -** Pending Claims in Co-pending Applications  
                         **Exhibit 2 -** International Cosmetic Ingredient Dictionary and Handbook ("CTFA"), 7<sup>th</sup> ed., p. 718 (1997)